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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,874	06/02/2004	Michael Zimmermann	LVIP113US	3873
24041	7590	10/30/2006	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			MICHALSKI, SEAN M	
			ART UNIT	PAPER NUMBER

3724

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/709,874

Applicant(s)

ZIMMERMANN ET AL.

Examiner

Sean M. Michalski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 2,5 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/04, 11/01/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>NPL(2)</u> . |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/29/04 and 11/04/04, the information disclosure statement was considered by the examiner.

Claim Objections

3. Claim 3 is objected to because of the following informalities: the "objective distance" is not a clear term. It would be more appropriate to define the objective in terms of the focal length, not an *implied* focal length. Appropriate correction is required.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention **specified in the claims**. Therefore, the "plurality of mounting surfaces" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "a plurality of mounting surfaces" **as described in the specification**. Any structural detail

that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 3, 4, and 6, which depend therefrom are likewise rejected. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The plurality of mounting surfaces are mentioned, but not described as to how they are places, with what they interact, or to what they connect. They are referenced in the same amount of detail in both the claims and in the specification, and they are not labeled in any of the drawings to give an actual and complete understanding of what feature is being referred to.

7. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The corners of the unit hood are not identified, nor is it clear what the recessed corners would do to allow the stereomicroscope to be moved *past* the hood without contact. It is not clear from the specifications or the drawings what applicant means when it is recited that the device may be pivoted past the hood. In the specification and the drawings combined Examiner does not believe that the device *is or may be* pivoted *past* the hood. One of ordinary skill would therefore not know how to create/use the claimed product. It seems as though applicant is claiming that by rounding the edges of the hood

(which moves *with the observation device*) it is less likely to strike it. This is an absurd and incorrect assertion.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, 6, 7, 8, and 10 are rejected under 35 U.S.C. 112 second paragraph.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim *does not clearly set forth the metes and bounds of the patent protection desired*. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 recites the broad recitation "a cutting apparatus", and the claim also recites "in particular a microtome or ultramicrotome" which is the narrower statement of the range/limitation. Claims 1, 3, 4, 6 are rejected.

In the present instance, claim 1 recites the broad recitation “an observation device”, and the claim also recites “in particular a stereomicroscope with an objective” which is the narrower statement of the range/limitation. Claims 1, 3, 4, 6 are rejected.

In the present instance, claims 3, 7, 8, and 10 recite the broad recitation “an increased working distance”, and the claims also recite “of 110mm” which is the narrower statement of the range/limitation. Claims 3, 7, 8, and 10 are rejected accordingly.

9. The relationship between the ‘plurality of mounting surfaces’ and the rest of the device, as recited in claim 1 is not understood. The recitation “for the linear guide” does not clarify the operation, positioning, interaction characteristics, or other critical information of the “plurality of mounting surfaces”.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1, as best understood, is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reichert (DE 4,012,600).

Regarding claim 1 see figure below:

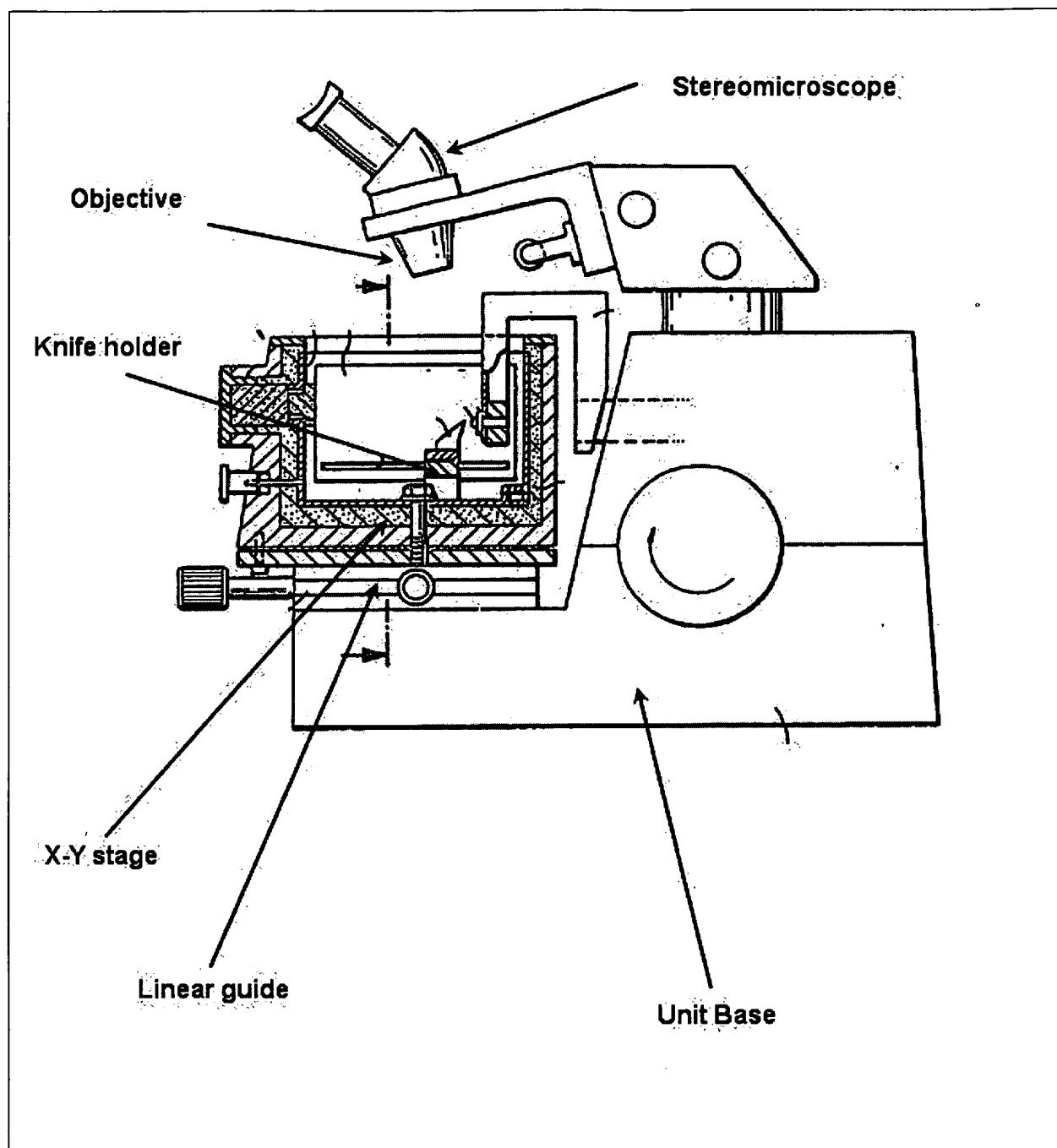


Figure 1

The linear guide guides the displacement linearly. There are multiple milled surfaces on the base that are capable of mounting with the linear guide.

12. Claims 1, and 4, as best understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sitte, Hellmuth (DE4111689).

Regarding claim 1, see figure below:

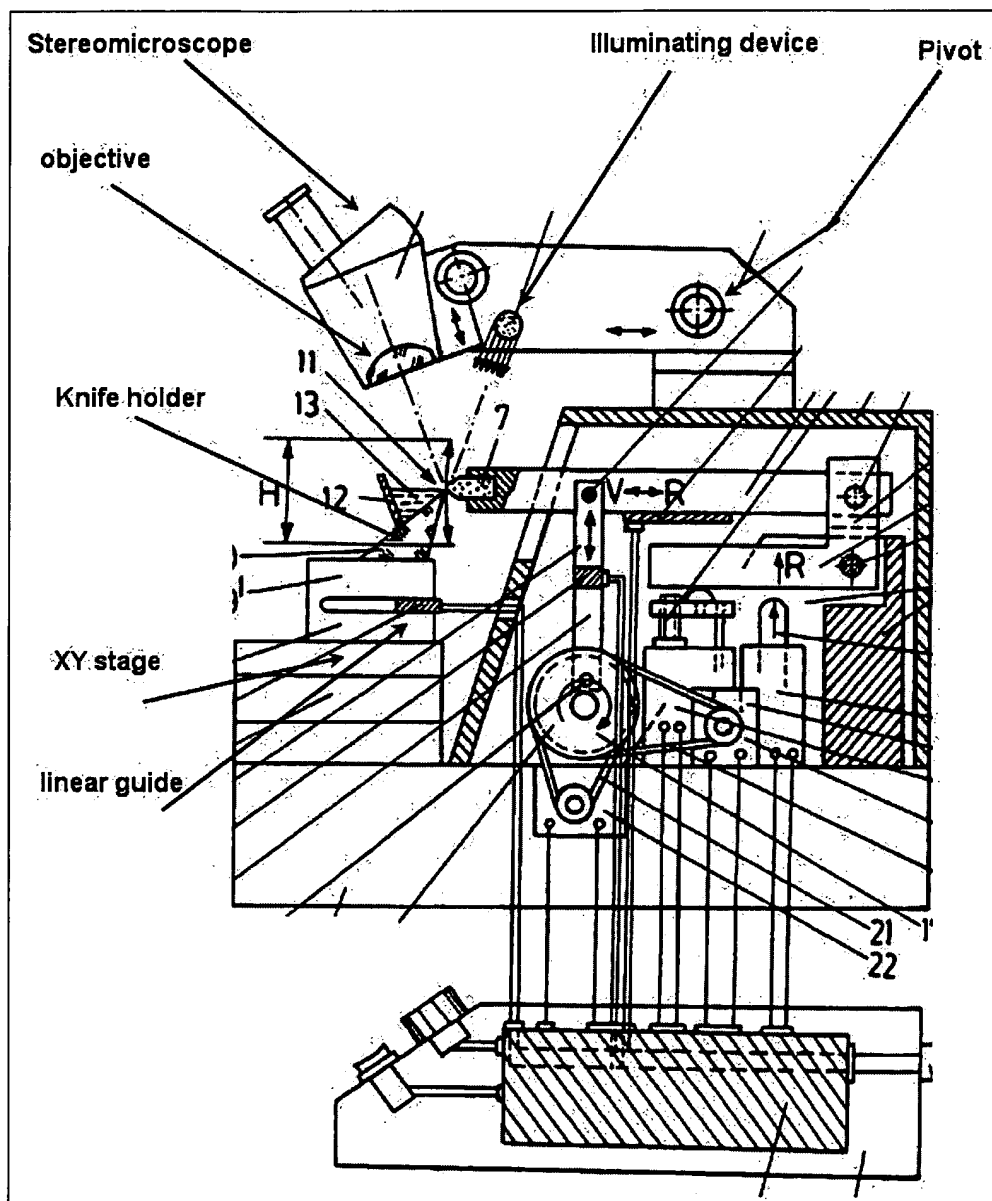


Figure 2

Although only disclosed as Kreuzsupport, the X-Y stage is properly characterized. An internet (google) picture search revealed *only* x-y stages when

'Kreuzsupport' was the sole search term. See attached record of that search. There are seen in the figure a plurality of mounting surfaces for the linear guide, milled in the base.

Regarding claim 4, as seen in figure 2 above, when the observation device pivots about the indicated joint pivot, the illumination device will pivot therewith.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Reichert (DE 4,012,600) or Sitte (DE4111689) in view of applicant's admission of prior art.

Regarding claim 3, Reichert (DE 4,012,600) or Sitte (DE4111689) teach all the limitations of claim 1.

Neither Reichert (DE 4,012,600) nor Sitte (DE4111689) teaches the limitation that the objective have a working distance of 110mm.

Applicant states "a working distance of 110mm instead of a working distance of 90mm". This shows that applicant was aware of 90mm working distances, and was merely changing the distance to be 110mm.

The distance of an objective is arbitrary. It may be modified with little or no skill so as to meet the given parameters of a setup. No criticality or explanation of the choice of 110mm is given in the specification. Applicant has stated that 110mm was chosen

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over a value of 90mm, which seems to be set forth as an accepted working distance. The modification from 90 to 110 surely would have been obvious to one of ordinary skill in the art, absent a showing that the results were unexpected, or of the secondary considerations of obviousness. The results clearly were not unexpected. It would have been expected that increasing the working distance would make "more space available". It is clear to one of ordinary skill in the art that providing more distance between things (objective and specimen) will make them further apart (making more space available).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the working distance of the objective 110mm in stead of 90mm, since it has been held that discovering an optimum result of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Also see MPEP 2144.07. *Sinclair & Carroll Co. v. Interchemical Corp.* states "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.). Since objectives are known to vary in working distances from several millimeters (the admitted prior art) to more than a meter (other commercially available lenses-see Questar extrinsic evidence), the designation of a specific lens (objective) does nothing to enhance the patentability of a design.

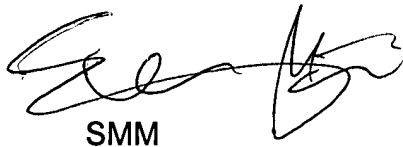
Claims 7, 8 and 10 are rejected identically to claim 3.

Conclusion

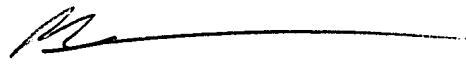
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SMM



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PRIMARY EXAMINER